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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

490-010115-US (PAR)

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on 2 March 2011

Signature

Typed or printed name Joseph V. Gamberdell

Application Number

09/771,052

Filed

26 January 2001

First Named Inventor

Vanttinen

Art Unit

2617

Examiner

Mehrpour

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 44,695

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

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Telephone number

2 March 2011

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(s): Veijo Vanttinen CONF. NO. 7249
SERIAL NO.: 09/771,052 ART UNIT: 2617
FILING DATE: 1/26/2001 EXAMINER: Mehrpour, Naghmeh
TITLE: LOCATION OF SUBSCRIBER TERMINAL IN PACKET-
 SWITCHED RADIO SYSTEM

ATTORNEY

DOCKET NO.: 324-010115-US (PAR)

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This is in response to the Office Action mailed 2 December 2011 for this patent application.

It is respectfully noted that in the present action, the Examiner maintains the rejection based on the previous Office Action dated 14 December 2009.

The combination of Verdonk et al. (US 6,330,454, "Verdonk") and Vialen et al. (US 6,826,406, "Vialen") fails to disclose or suggest:

the subscriber terminal transmitting a request message for location service pertaining to the subscriber terminal to the core network of the radio system via the radio network of the radio system,

as substantially recited by claims 1 and 18.

1. Applicants respectfully submit that the present action is defective because this limitation has not been addressed.

When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1057 (Fed. Cir. 1993).

Applicants refer to 37 CFR 1.104(c)(2):

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (Emphasis added)

and MPEP §707:

When considered necessary for adequate information, the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s), and/or any relevant comments briefly stated should be included.

MPEP §706.07 emphasizes the specificity requirement of 37 C.F.R. § 1.104(c) by stating:

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

Applicants submit that because the above limitation is not addressed in the present action, it is unclear which features of the cited references the Examiner equates with this element of the present claims and, as a result, a clear issue has not been developed.

Applicants request a new action with more specificity in the rejection, for example, by citing columns and line numbers in the references related to this feature of the claims and a comparison among features in the references and this element of the present claims.

2. Referring to columns 5 and 6 of Verdonk, cited by the Examiner, a customer server 140 initiates operations by sending location request including a MIN or telephone number of a mobile unit and a request for the unit's last location or current location. The customer server 140 sends the location request to the SCP 142 (or SN 141) which sends a locate request to the HLR, either directly or through the originating MSC. The HLR sends a route request to the serving MSC.

If the unit's current location has been requested, the serving MSC sends a page to the mobile unit. Based on the response from the mobile unit, the serving MSC determines the cell in which the terminal resides.

Applicants note that the request for location determination originates in the network and not in the terminal. The network requests a page response from the terminal. The terminal does not request any information at all.

The present action states on page 3, line 18 through page 4, line 4, and again on page 9, line 22 through page 10, line 7, that the mobile unit responds with its location, cell identity, longitude and latitude information, and a time stamp related to the last location. Applicants respectfully submit that this is incorrect and that there is no disclosure that the mobile station responds with any location data at all. Verdonk only states that the serving MSC receives a time stamp and cell/sector information from the VLR and converts it to longitude and latitude (col. 5, lines 42-44), the serving MSC determines the cell based on the page response (col. 5, lines 53-55), that the MSC stores the cell/sector from which the terminal responds (col. 7, lines 41-43), or that the BSC identifies the cell/sector from which the terminal responds (col. 8, lines 30-32). It is clear that the network elements determine the time stamp, cell/sector information, and longitude and latitude, not the mobile terminal.

The present action further states on page 4, lines 5-6 and again on page 10, lines 8-9 that Verdonk does not specifically mention that the connection is a UM connection from the radio network to a subscriber terminal. Applicants fail to find this limitation in claims 1 and 18 and fail to understand its relevance.

3. The present action then cites Vialen as teaching that the connection is a UM connection from the radio network to a subscriber terminal. Again, Applicants fail to find this limitation in claims 1 and 18 and fail to understand its relevance.

Vialen is directed to a method of reconfiguring a cellular radio network connection. A mobile station sends a reconfiguration request message comprising a radio bearer identification and a quality of service of the identified bearer. The network part attempts to reconfigure the bearer and sends a message indicating success or failure. Applicants submit that there is nothing in Vialen related to a subscriber terminal transmitting a request message for location service pertaining to the subscriber terminal to a core network of a radio system via a radio network of the radio system.

CONCLUSION

For all the reasons above, Applicants respectfully submit that the combination of cited references fails to disclose or suggest all the features of the present independent claims.

Applicants respectfully submit that the present action is defective because all the limitations of claims 1 and 18 have not been addressed.

Review is respectfully solicited with an aim to providing some meaningful prosecution or the allowance of this application.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

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2 March 2011
Date

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